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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPT.
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

CHANG, SUNRAY

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,786

Applicant(s)

FISCHER ET AL.

Examiner

Sunray Chang

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFF 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in responsive to the paper filed on June 5th, 2006.

Claims 1 – 14 are presented for examination.

Claims 1 – 14 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1, 3, 5, 7, 9 and 14 are rejected** under 35 U.S.C. 102(e) as being anticipated by Keyes et al. (U.S. P.G. Pub No. 2004/0204775, and referred to as **Keyes** hereinafter).

Regarding independent claim 1,

Keyes teaches,

- Process control system (see pg 2, col 2, para 0018, lines 6-8) comprising:

- A processor unit (see **Figure 2, element 73** and see pg 5, col 2, para 0040, lines 1-4 and line 9 to col 2, lines 1-2) adapted to determine a payment figure from operations running in the process control system regarding the creation or removal of a process control function or regarding a user activity or regarding an execution of an automation function. (see pg 5, col 1-col 2, para 0040)

Regarding Claim 3,

Process control system (*see pg 2, col 2, para 0018, lines 6-8*) according to Claim 2, further comprising:

- At least one field device for automation of at least one system component, wherein at least a part of the operations running in the process control system run on the field device. (*see pg 1, col 1, para 0003, lines 6-22*)

Regarding Claim 5,

A process control system (see pg 2, col 2, para 0018, lines 6-8) according to claim 4, wherein the further components comprise

- field devices for monitoring and control of components of a technical system (see pg 2, col 2, para 0018, lines 14-23) that are connected by radio communication and/or by a fixed link to the process control computer (see pg 3, col 2, para 0024, lines 5-12), wherein further operations also comprise those operations that are executed in field devices. (see pg 1, col 1, para 0003, lines 10-22)

Regarding Claims 7 and 9 – 13,

- Process control system wherein the payment figure is a service fee to be paid by the user of the process control system to an Application Service Provider. (see pg 16, col 2, para 0014).

Regarding Claim 14,

- A method for determine a payment figure in a process control system, comprising:
- providing a processor unit (see Figure 2 element 73 and pg 5, col 1, para 0040, lines 1-4 and line 9 to col 2, lines 1-2) adapted to record the creation and/or removal of a process Control function and an execution of an automation function; (see pg 5, col 1-col 2, para 0040) Providing a device to adapted to record a user activity; (see figure 3, element 138-Database and Figure 2, element 74-Services) and Determining a payment figure by the processor unit using recorded data of the preceding steps. (see pg 16, col 2, para 0114)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 2, 4, 6, and 8 are rejected under 35 U.S.C. 103(a)** as being unpatentable over **Keyes** in view of Hsiung et al (United States Publication Number: 200310144746) hereinafter referred to as **Hsiung**.

(**Keyes** as set forth above generally discloses the basic inventions.)

Regarding claims 2, 4, 6 and 8,

Keyes teaches a process control system that utilizes economic calculations however

Keyes fails to teach a process control computer, a client computer, the Internet wherein at least a part of the operations running in the process control system run on the process control computer; a process control system wherein the process control computer comprises a Web server and the client computer comprises an Internet browser so that the client computer can influence the operations running in the process control computer via the Internet, wherein the operations can also include operations by which further operations are initiated in further components of the process control system; and a process control system

wherein communication between the components of the process control system is based on the TCP/IP transmission protocol (TCP/IP).

However, **Hsiung** teaches a process control system further comprising: a process control computer; (see figure 1, element 115-PLC, element 129-SCADA and see pg 3, col 1, para 0030, lines 3-11) a client computer; (see figure 1; element 112 and see pg 3, col 1, para 0027, lines 1-2) and the Internet (see Figure 1, element 109-Internet) wherein at least part of the operations running in the process control system run on the process control computer. (see pg 3, col 1, para 0030, lines 1-12 to col 2, lines 1-3) A process control system wherein the process control computer comprises a Web server (see pg 4, col 1, para 0038, lines 17-22) and the client computer comprises an Internet browser so that the client computer can influence operations running in the process control computer via the Internet (see pg 18, col 2, para 0277 and para 0278, lines 1-2), wherein the operations can also include operations by which further operations are initiated in further components of the process control system. Process control system wherein communication between the components of the process control system is based on the TCP/IP transmission protocol (TCP/IP). (see pg 4, col 1, para 0038, lines 10-15)

It would be obvious to one of ordinary skill in the art to modify the invention of **Keyes** by including the methodologies of **Hsiung** to not only allow for better communication between the process control computer and the client computer within the process control system, but also to allow better operation by giving the user and user

operations more interactive power to affect the process and control of the process control system.

Response to Amendment

Claim Rejections - 35 USC § 102 & 103

4. Applicants' arguments to disqualify the reference **Keyes** to be a prior, which has been cited by examiner for both forth and current rejections, by arguing the US provisional Application 60/273,164 (**Keyes** priority document), filed on March 1st, 2001, does not disclose the subject matters for which the examiner uses **Keyes**, is disagreed with.

US provisional Application 60/273,164 (**Keyes** priority document) discloses the subject matters in the specification as below: [Page 57, lines 21 – 29]

“In this manner, the remote monitoring facility 910 can execute the software for asset, performance, condition and process monitoring as well as executing one or more optimizers for different plants. This, in turn, means that the plants 900-903 do not need to include the processing power or applications for these purposes, which may be less expensive for the plants. Of course, the plants may pay on a per usage basis or on some other predetermined fee schedule for use of the remote monitoring facility 910. If desired, the remote monitoring facility 910 may contract to get a portion of the profits and/or losses of the plant based on the use of the tools at the facility 910 and the implementation of the results of those tools.”

The rejections have been retained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunray Chang whose telephone number is (571) 272-3682. The examiner can normally be reached on M-F 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-3506.


Anthony Knight
Supervisory Patent Examiner
Group 3600